

Attorney's Docket No.: 5577-108

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Cox, et al.

Serial No.: 09/211,527

Filed: December 14, 1998

For: METHODS, SYSTEMS AND COMPUTER PROGRAM PRODUCTS FOR POLICY
BASED NETWORK CONTROL OF CHARACTERISTICS OF USER SESSIONS

Confirmation No.: 9792

Group Art Unit: 2155

Examiner: F. Backer

Date: April 24, 2002

Commissioner for Patents
Washington, DC 20231

**APPELLANTS' REPLY BRIEF ON APPEAL
UNDER 37 C.F.R. 1.193(b)**

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I. INTRODUCTION

The present Reply Brief is provided to respond to the issues raised by the "Response to Argument" portion of the Examiner's Answer mailed February 26, 2002. Appellants submit that, for the reasons discussed in Appellants' Appeal Brief and clarified below, the claims are not obvious in light of Shewd and Belfiore. Appellants incorporate each of the arguments and positions in the Appeal Brief in the present Reply Brief as if set forth fully herein. In the interests of brevity, these arguments and positions will not be reproduced below.

II. THE EXAMINER'S ANSWER FAILS TO ADDRESS APPELLANTS' ARGUMENTS

Appellants submit that the Examiner's Answer fails to establish a *prima facie* case of obviousness as Examiner's Answer fails to set forth a convincing line of reasoning which indicates (1) where the recitations of the claims are found in the references, (2) fails to provide an adequate motivation to combine the references to result in the claimed invention and (3) fails to address Appellants' arguments with respect to the dependent claims.

A. The Claims Are Patentable Over Shewd and Belfiore

The Examiner's attempts to refute Appellants' arguments, evidence that the Examiner

either fails to appreciate Appellant's position or has chosen to ignore Appellant's position. However, even were the burden not on the Examiner to establish a *prima facie* case of obviousness, Appellants have established that one could not be made based on Shewd and Belfiore. In summary, neither Belfiore nor Shwed disclose or suggest "modifying the content provided by the network device to the device based on the policies and the provided session dependent information so as to modify the content provided to the user of the device" as recited in the independent claims (9, 23 and 27).

As discussed in Appellants' Appeal Brief, in the Final Office Action the Examiner acknowledges that Shewd fails to teach modifying the content provided to the device of the user so as to modify the content provided to the user of the device but asserts that Belfiore provides such a teaching. *See* Final Office Action, page 3. The Examiner's Answer states that "Applicant further argues that neither Shewd nor Belfiore disclose or suggest 'modifying the content provided by the network device to the device based on the policies and the provided session dependent information so as to modify the content provided to the user of the device.'" *See* Examiner's Answer, page 3. Examiner's Answer then states that "Examiner respectfully disagrees with applicant [sic] perspective of Shrewd [sic] inventive concept" and continues by explaining the Examiner's interpretation of the Shewd reference. The Examiner's Answer never mentions the Belfiore reference, which supposedly contains the missing teachings according to the Final Office Action. Thus, the Examiner's interpretation of the cited references is incorrect and inconsistent with the Examiner's interpretation of the cited references in the Final Office Action. Without a teaching of modifying the content provided by the network device to the device based on the policies and the provided session dependent information so as to modify the content provided to the user of the device, all of the recitations are not found in the prior art. The Examiner's Answer never sufficiently addresses this fatal flaw of all of the rejections. Accordingly, the rejections of the claims should be reversed.

**B. The Examiner's Answer Does not Provide a Proper Motivation to
Combine the Cited References**

In response to Appellants' argument that there is no motivation to combine the cited

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references as suggested by the Examiner, the Examiner states that "[i]n this case the reason for combining the references is based on the knowledge readily available in the art." See Examiner's Answer, page 3. This statement does not satisfy the Examiner's burden as discussed in full in Appellants' Appeal Brief. See Appeal Brief, pages 3-4. In a recent decision, the Court of Appeals for the Federal Circuit held that an examiner's conclusory statements do not adequately address the issue of motivation to combine. *In re Sang-Su Lee*, 277 F.3d 1338, 1343. The Court stated that "this factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." *Id.* at 1343-44. The Court went on to say that "'common knowledge and common sense' even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority." *Id.* at 1345. Thus, the Examiner must point to the specific portions of the cited references that provide the suggestion or motivation to combine, and cannot rely on unspecified "knowledge readily available in the art." The Examiner has not pointed to these specific teachings, but instead has engaged in the type of conclusory reasoning based on subjective belief and unknown authority rejected by the Federal Circuit. Accordingly, Appellants submit that the Claims of the present invention are not obvious in light of Shewd and Belfiore for at least these additional reasons.

**C. The Examiner's Answer Ignores Appellants' Arguments with
Respect to the Dependent Claims**

While either of the above arguments alone provide sufficient grounds for reversal of all of the rejections of the pending claims, the Examiner's Answer further fails to address Appellants' arguments with respect to the dependent claims. As set forth in Appellants' Appeal Brief, Appellants argue that many of the dependent claims are independently patentable over the cited references. See Appeal Brief, pp. 8-10. Furthermore, Appellants have argued the patentability of the dependent Claims multiple times and have specifically requested clarification as to the basis of the rejection of the dependent claims. Still, the Examiner fails to even address Appellants' arguments with respect to the dependent Claims. At this point, Appellants can only assume that the reason the Examiner refuses to clarify these

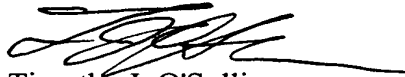
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rejections is because he has nothing to say. Thus, these claims should be deemed independently patentable over the cited references. Appellants request reversal of the rejections of the dependent claims for at least these reasons.

IV. CONCLUSION

As is clear from the above discussion, the Examiner's Answer has failed to establish a prima facie case of obviousness as it has failed to show the presence of all of the recitations of the claims as being found in the cited references, has failed to provide a convincing line of reasoning as to why the cited references would be combined to result in the recitations of the claims, and has failed to even address the dependent claims. Accordingly, Appellants requests reversal of the rejections of the pending claims.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Patents, Washington, DC 20231, on April 24, 2000.



Traci Brown

Date of Signature: April 24, 2002